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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/214,277 03/01/99 KAWADA K 32-248P

HM22/1017
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH VA 22040-0747

EXAMINER

BALASUBRAMANIAN, V

ART UNIT

PAPER NUMBER

1624

DATE MAILED:

10/17/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/214,277

Applicant(s)

Kenji et al.

Examiner
Venkataraman Balasubramanian

Group Art Unit
1624



- ☐ Responsive to communication(s) filed on _____
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 1-17 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 1-17 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Applicants' preliminary amendment which included amendment to claims 5, 15-17 and addition of claims 26-30 and cancellation of claims 23-25 filed on 4/4/200 is acknowledged but not made of record. The following discrepancy in the number of claims is noted.

1. There are 17 claims as filed originally, before the preliminary amendment. Note the page on claim 17 ends is 478 and the very next page is abstract of the disclosure. Hence there is no possibility of missing pages.
2. Preliminary amendment appears to indicate there were 25 claims and cancels claims 23-25. Since there are no claims 18-25 in the case, it is not possible to cancel them or amend them.
3. The new claims 26-30 appears to be also were not present in the parent PCT/JP/02635 as evidenced by the International Search Report.
4. Applicants should note that 37 CFR 1.496 prohibits the addition of new claims in a 371 of a PCT case ie. claims not identical to the PCT case.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 7-12, drawn to compound of formula I and composition.

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Group II, claim(s) 13-14, drawn to compound of formula I'' and composition.

Group III, claim(s) 15-17, drawn to processes for making compound of formula I'''.

Group IV, claim(s) 1-6 drawn to what appears to be an immunosuppressor of IgE production composition comprising a compound whose structure not disclosed.

If group III is elected applicant should elect a specific process of claims 15-17. If group IV is elected applicants should elect species of the compound recited therein with support in the specification.

The inventions listed as Groups I, II, III and IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Where there is lack of unity the requirement for restriction is proper- See MPEP 803.02. The requirement for unity of invention is two-fold: (1) common utility and (2) sharing a substantial structural feature disclosed as being essential to the utility. In the instant case compounds of Group I and II can have different utility as evidenced by Tringali et al. who disclose antibiotic activity and Kallitsis et al who teach use in polymers. Furthermore, the terphenyl ring common to groups I and II are not solely responsible for the physiological activity being relied on herein- applicants own test results confirm this.. Furthermore, the restriction is consistent with applicants' expected urging of patentability for instant compound of formula I over formula I''. In addition, MPEP permits one product, one process, one composition and one method of use in a single invention. In this regard as claimed there are two distinct compounds namely compound of formula I and formula I''. Also

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applicant should note that compound of formula I is the first recited compound. See also Official Gazette, 1134 OG 194, Jan 7, 1992 which clearly shows US position as regards to PCT cases .

As for group III is concerned it recites processes for making compound of formula I'' which is as recited is different from that of group I or group II . Hence it is distinct from the process of making compound of formula I or formula I'. Furthermore, applicants would not acquiesce to obviousness type rejection of subject matter of Group I or II over prior art Akira et al. (provided by the applicant)which reads on group III.

As for group IV, it relates to composition for immunosuppression of IgE with indeterminate scope as it is not clear what compound is included or excluded. Furthermore, applicants would not acquiesce to obviousness type rejection of subject matter of Group I or II over prior art JP 525'45 et al. (provided by the applicant) which reads on group IV.

Restriction is proper where there is lack of unity of the invention and such is not affected by the manner of claiming- ie. In separate claims or within a single claim. Note 37 CFR 1-141 (a) which states two or more independent distinct inventions may not be claimed in one application. One appearing in one claim or more than one claim. This is also consistent with the PCT rule 13.3 for PCT cases entering the national stage.

In view of distinct nature of the inventions, a restriction is set forth in writing.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on weekdays from 8.30 AM to 5.00 PM.

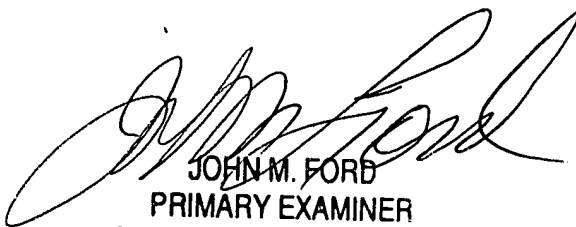
The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

VB

V. Balasubramanian (Bala)

10/13/2000


JOHN M. FORD
PRIMARY EXAMINER
GROUP 1624 - ART UNIT 1624